



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/606,897 06/29/00 LIN

S RDA 89, 817

<input type="checkbox"/>	EXAMINER
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WM01/0920

JOSEPH S. TRIPOLI
PATENT OPERATIONS - THOMSON MULTIMEDIA
LICENSING INC.
CN 5312
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PTTOS, A	ART UNIT	PAPER NUMBER
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2651
DATE MAILED:

09/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/606,897	LIN ET AL.
	Examiner	Art Unit
	Aristotelis M Psitos	2651

The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

THE MAILING DATE OF THIS COMMUNICATION IS:

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 December 2000 .

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-3, 6-13 and 16-20 is/are rejected.

7) Claim(s) 4, 5, 14 and 15 is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. ____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) Other: _____

DETAILED ACTION

Specification

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

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Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 8 and 11 and 18 are rejected under 35 U.S.C. 102(a) as being anticipated by Kondo et al.

Kondo et al discloses an editing system wherein reordered positions of recorded information are provided for by rewriting start and end points in the TOC of the disc. Applicants' attention is drawn to the disclosure at col. 16 the discussion with respect to divide and combine edit functions. This meets the independent claim 11. With respect to claim 18, the examiner interprets the display of the combining ability – see col. 18 lines 60+ to meet this limitations. The method limitations(claims 1 and 8)are met when the system operates.

7. Claims 1 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Aramaki et al.

Aramaki et al discloses an editing system wherein the management information is rerecorded to provide for update abilities – editing – see col. 36 lines 35 –50 for instance - such as skipping etc.

As far as the examiner can interpret the system of Aramaki et al – the pointers act as the ability to rewrite the start and end address points. The method limitations of claim 1 are met when the system of Aramaki et al operates.

8. Claims 1 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Nagasawa.

Nagasawa in describing the conventional editing system provides for the rerecording of the new addresses in the TOC – see col. 4 lines 8 – 12 for instance.

As far as the examiner can interpret this description it anticipates the claimed functional (method claim 1) and apparatus claim 9.

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 2 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of the cited prior art as applied to claim 1 above, and further in view of Hasegawa et al.

None of the prior art relied upon with respect to claim 1 indicates an ability of both fwd and bwd

✓ playback. Such an ability is considered known as taught by the Hasegawa et al reference. The further ability of having the control signal able to cause a jump in either forward or backward directions is considered a logical extension of the fwd and bwd playback abilities available in DVD systems.

It would have been obvious to one of ordinary skill in the art to modify the system of any of the above noted prior art systems cited with respect to claim 1 with the teaching from Hasegawa et al, motivation is to update their abilities as system parameters are updated, i.e., permit bwd playback/scan.

13. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 2 above, and further in view of Taira et al.

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The specific cell format is considered to be inherently present in Taira et al. The examiner interprets the limitations of claim 3/13 as descriptive of the MPEG-2 format noted in Taira et al.

It would have been obvious to one of ordinary skill in the art to modify the system of the prior art as relied upon with respect to claim 2 with the teaching from Taira et al, motivation is to save valuable resources by updating the systems ability to playback MPEG-2 formated records.

14. Claims 6 and 7 and 16 ad 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 2 above, and further in view of Taira et al.

The limitations/ability of re-indicating start and end points/addresses is considered to be taught by the Taira et al system. This re-indication is interpreted by the examiner as being predicated upon the MPEG-2 format noted in Taira et al.

It would have been obvious to one of ordinary skill in the art to modify the system o the prior art as relied upon with respect to claim 2/12 with the teaching from Taira et al, motivation is to save valuable resources by providing for upward compatible editing systems for new signal formats as they become introduced into he market place.

15. Claims 9 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 8 above, and further in view of erasure procedure well known in the magnetic arts.

As known to those in the magnetic recording arts – and those using PCs, the ability to “erase” a segment of information on the record/disc is enabled by using the erase feature. This erase feature places an appropriate signal at the start of the record segment indicating that the following segment/information is no erased/eraseable. The examiner interprets the “erase” function as the teaching of a restriction flag ability.

It would have been obvious to one of ordinary skill in the art to modify the system of the prior art as relied upon with respect to claim 8/18 with the teaching from erasing segments on magnetic discs, motivation is to save valuable resources by not reinventing the wheel and using existing techniques to create appropriate control flags.

16. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the above art as applied to claim 2 above, and further in view of Greenwood et al/Official notice.

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The ability of creating edit tables/ or erased tables is considered to be either taught by the Greenwood et al reference – see his description of edit tables. Alternatively, when one erases information on a mag. Disc, a table is generated that keeps track of the amount of empty space on the disc. The examiner recommends applicants to use their PC and erase selected segments on either their hard drive or an inserted floppy. Then applicants can discover how much empty space is found on this disc before and after erasure. Note that the amount of empty space is noted by their PCs. The examiner interprets such as predicated upon the existing of a "table" that keeps track of the amount of empty space (normally in the TOC) on the disc.

It would have been obvious to one of ordinary skill in the art to modify the system of the above art as relied upon with respect to claim 2/12 with the teaching from either Greenwood et al or Official notice, motivation is to provide some inventory indication to the user of his records.

Conclusion

17. Claims 4,5,14 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kawamura et al, Ro et al and Saoyama et al are cited as illustrative of prior editing systems in this environment.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M-Thursday 8 - 4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703) 308-4825. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

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Aristoteles M. Psitos
Primary Examiner
Art Unit 2651

AMP
September 17, 2001